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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,574	06/01/2001	Charles B. Dickinson	CBD-001	2676

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EXAMINER

TAMAI, KARL I

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 05/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,574

Applicant(s)

DICKINSON, CHARLES B.

Examiner

Tamai IE Karl

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 23-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-18, 21 and 22 is/are allowed.
- 6) ☐ Claim(s) 1, 3-8 and 19 is/are rejected.
- 7) ☒ Claim(s) 2 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22 drawn to an superconductive generator, classified in class 310, subclass 52.
 - II. Claims 23-30, drawn to a superconductive coil, classified in class 335, subclass 216.
2. Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because spiral coil or the channel mold of Group II. The subcombination has separate utility such as a superconductive coil for a motor, magnetic bearing, sensor, or an MRI machine.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for the channel mold and spiral coil of Group II is not required for Group I, therefore the restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Eugene Thigpen on May 20, 2002 a provisional election was made with traverse to prosecute the invention of Group I,

claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Oath/Declaration

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4-7, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowsett et al. (Dowsett)(US 3,443,134), Kambe et al. (Kambe)(EP 653 829), and Sato et al. (Sato)(US 4,740,711). Dowsett teaches a homopolar power generator having a superconductive coil 9 enclosed in a container 10 with an electrical conductor 3,4 (Faraday disks) mounted on a rotating shaft. Dowsett teaches every aspect of the invention except it does not teach the container specifically having cryogenic fluid, a prime mover, or the conduit for supplying a gaseous stream from a pressurized source to the prime mover. Kambe teaches a cryostat with a cryogenic fluid to cool the stator coil below a critical temperature. Sato teaches a pressurized source driving a turbine to produce electrical energy. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the generator of Dowsett with the turbine of Sato to drive the shaft and generate electricity, and with the cryostat of Kambe because Dowsett teaches that any cryostat can be used, and because Kambe teaches the cryostat provides a simple homopolar machine.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dowsett et al. (Dowsett)(US 3,443,134), Kambe et al. (Kambe)(EP 653 829), and Sato et al. (Sato)(US 4,740,711), in further view of Nikola Tesla(US 1,061,206). Dowsett, Kambe, and Sato teaches every aspect of the invention except the prime mover being spaced apart disks. Tesla teaches that spaced apart disks provide a reliable turbine that can operate in both directions. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the generator of Dowsett, Kambe, and Sato with the turbine of Tesla to provide a reliable turbine that operates in both direction.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dowsett et al. (Dowsett)(US 3,443,134), Kambe et al. (Kambe)(EP 653 829), and Sato et al. (Sato)(US 4,740,711), in further view of Joshi (US 5,482,919). Dowsett, Kambe, and Sato teaches every aspect of the invention except the cryogenic fluid being nitrogen and the superconductive material being yttrium barium copper oxide. Joshi teaches the cryogenic fluid can be nitrogen and the superconductive material can be yttrium barium copper oxide. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the generator of Dowsett, Kambe, and Sato with the cryogenic fluid being nitrogen and the superconductive material being yttrium barium copper oxide because Joshi teaches these are good materials for superconductive devices and because it is within the ordinary skill in the art to choose materials from known equivalents.

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Allowable Subject Matter

12. Claims 9-18, 21, and 22 are allowed.
13. Claims 2 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai whose telephone number is (703) 305-7066.

The examiner can be normally contacted on Monday through Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nestor Ramirez, can be reached at (703)308-1371. The facsimile number for the Group is (703)305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Karl I Tamai
PRIMARY PATENT EXAMINER
May 29, 2002

KARL TAMAI
PRIMARY EXAMINER

